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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/566,736

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Volker Brod

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EXAMINER

MCCLELLAND, KIMBERLY KEIL

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/566,736	<b>Applicant(s)</b> BROD ET AL.	
	<b>Examiner</b> KIMBERLY K. MCCLELLAND	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-28 is/are pending in the application.
- 4a) Of the above claim(s) 20-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/04/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group I, claims 11-19 in the reply filed on 08/14/08 is acknowledged.
2. Claims 20-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 08/14/08.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The term "thermodes" is not properly enabled in the current specification. One of ordinary skill in the art would not know how to make or use thermodes. The inventor has not provided any direction as to how one might use thermodes. No examples of thermodes have been given. The state of the art for rf transponders does not include thermodes. There is no predictability in the art of thermodes to allow one of ordinary

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skill in the art to form them. There is undue experimentation required to make thermodes based on the information disclosed in the specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by the term "thermodes". No adequate definition for this term is given in the specification. It is unclear what limitations this term imparts to the currently claimed invention. Clarification is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 11-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication No. 2003/0136503 to Green et al.

9. With respect to claim 1, Green et al. discloses an RFID labeling apparatus, including a first device for outputting the at least one web material (500) at a predefined speed; a carrier belt (See paragraph 0023) for transporting the one or more transponder devices at the predefined speed; and a bonding device (ABD) for bonding the one or

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more transponder devices to the at least one web material at the predefined speed (See paragraphs 0089-0091 and Figure 10).

10. As to claim 12, Green et al. discloses the bonding device comprises at least one unit for producing at least one of a soldering bond, an adhesive bond, a laser-welded bond, or an ultrasonic bond (See paragraph 0091).

11. As to claim 13, Green et al. discloses the carrier belt includes a belt (See paragraph 0023) for supporting the one or more transponder devices, and a supply unit for supplying the transponder devices to the belt (608).

12. As to claim 14, Green et al. discloses the supply unit comprises at least one unwinding roll (608) and a speed regulating unit (See paragraph 0089). Examiner notes the phrase, “for measuring the speed of the carrier belt and the first device and for synchronizing the speed of the carrier belt with the speed of the first device” is considered intended use of the currently claimed invention. Consequently, this limitation is not found to structurally define the current invention.

13. As to claim 15, Green et al. discloses the bonding device comprises a curing unit for curing the bonds according to at least one of air, UV irradiation, laser irradiation, thermodes or electron beam irradiation (See paragraph 0091).

14. As to claim 16, Green et al. discloses a plurality of carrier belts and corresponding bonding devices that are positioned at predefined locations relative to the at least one web material (See paragraphs 0101-0103).

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15. As to claim 18, Green et al. discloses the bonding device includes two rollers, the rollers rotate counter to each other and the carrier belt releases the transponder devices prior to being fitted to the at least one web material via the rollers (A/B; See Figure 10).

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0136503 to Green et al. as applied to claims 11-16 and 18 above.

18. With respect to claim 17, Green et al. discloses different methods of fitting the transponder devices to the at least one web material are equivalent (see paragraph 0091). Green et al. also discloses multiple transfer units may be used to transfer a series of rf components (See paragraphs 0101-0103). Green et al. does not specifically disclose the plurality of bonding devices perform two or more different methods of fitting the transponder devices to the at least one web material. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use bonding devices performing two or more different methods of fitting the transponder devices to the at least one web material, because the different bonding devices are known in the art to be equivalent. Simple substitution of one known bonding method for

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another would yield the predictable result of effectively bonding a plurality of rf components to a web.

19. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0136503 to Green et al. as applied to claims 11-16 and 18 above, and further in view of U.S. Patent No. 6,280,544 to Fox et al.

20. With respect to claim 19, Green et al. does not specifically disclose the carrier belt includes a wedge-shaped device for changing the running direction of the belt to a direction approximately opposite to the running direction of the at least one web material, thereby releasing each of the transponder devices at the point of direction change of the belt.

21. Fox et al. discloses an rf tag application system, including a wedge-shaped device (16) for changing the running direction of the belt to a direction approximately opposite to the running direction of the at least one web material, thereby releasing each of the transponder devices at the point of direction change of the belt (See Figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the peel bar taught by Fox et al. with the apparatus of Green et al. The motivation would have been to improve separation of the rf component from the rf sheetstock, improving production speed and efficiency.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY K. MCCLELLAND whose telephone number is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kimberly K McClelland/  
Examiner, Art Unit 1791

KKM

/Philip C Tucker/  
Supervisory Patent Examiner, Art Unit 1791